



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,713	03/08/2001	Klaus Krinner	F-6818	7592

7590 10/07/2003
Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
----------	--------------

3632

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,713

Applicant(s)

KRINNER ET AL.

Examiner

Tan Le

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-42 is/are pending in the application.
- 4a) Of the above claim(s) 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This is the fourth office action for application serial number 09/762,713. This application remains 23 claims numbered 33-42. Claims 20-32 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention as pointed out in the previous office action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 33-35, 38-39 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,457,918 to Plourde in view of US Patent No. 4,852,380 to Haldric et al.

Regarding claims 33-35, Plourde discloses an anchoring device (Fig. 4) which comprises a basic body (10) having an anchoring portion (14, 18) and a holding portion (20, 22, 30, 32E) for receiving an object; the anchoring portion having a first portion (18) and a second portion (14) being formed from one piece; the first portion being cone-shaped with a first cone angle, the second portion being coned-shaped with a second angle different from the first cone angle; threads (52) extended substantially over the entire length of the anchoring portion for screwing the anchoring portion into the ground; and the holding portion and anchoring portion are substantially hollow.

Plourde teaches forming a basic body by manufacturing machine, but does not teach forming the basic body by hammering of a cylindrical tube.

Haldric teaches that it was known in the art to have formed a basic body by hammering of a cylindrical tube.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the technique of Lesar by implementing the technique of Haldric which forms a basic body by hammering of a cylindrical tube so as to impart the tube in a particular configuration without the use of a complex machine. Nonetheless, the use of hammering a tube to form a basic shape is conventional and well known and to use such in a same intended purpose would have also been an obvious matter of design choice.

Regarding claims 38-39, Plourde as modified also discloses the anchoring portion and the holding portion are one piece and the anchoring portion being attached to the holding portion.

Regarding claims 40 and 42, Plourde as modified also discloses the anchoring portion having a tip (38); and the difference between the first cone angle and the second cone angle is in the range between 1 and 3 degrees.

Claims 35- 39, 40 and 42 are also rejected under 35 U.S.C. 103(a)) as being unpatentable over US Patent No. 5,524,855 to Lesar in view of US Patent No. 4,852,380 to Haldric et al.

Regarding claim 35, Lesar discloses an anchoring device (Figs. 4-7) which comprises a basic body having an anchoring portion (24, 34, 36); the anchoring portion having a first portion (22) and a second portion (10, 12, 34, 36) being formed from one piece; the first portion being cone-shaped with a first cone angle, the second portion being coned-shaped with a second angle different from the first cone angle; the basic

body also having a holding portion (24); and the holding portion and anchoring portion are substantially hollow.

Lesar teaches forming a basic body by manufacturing machine, but does not teach forming the basic body by hammering of a cylindrical tube.

Haldric teaches that it was known in the art to have formed a basic body by hammering of a cylindrical tube.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Lesar by implementing the technique of Haldric which forms a basic body by hammering of a cylindrical tube so as to impart the tube in a particular configuration without the use of a complex machine. Nonetheless, the use of hammering a tube to form a basic shape is conventional and well known and to use such in a same intended purpose would have also been an obvious matter of design choice.

Regarding claims 36-39, Lesar as modified also discloses at least 3 or four fins structures (20, Fig. 4) attached to the basic body in an equiangularly spaced manner; and the anchoring portion and the holding portion are one piece.

Regarding claim 40, Lesar as modified also does not disclose the difference between the first cone angle and the second cone angle being between 1 and 3 degrees. However, it would have been an obvious matter of the design choice to make the cone angles between 1 and 3 degrees, since one skilled in the art can make a variety of different angles if so desired.

Regarding claim 42, Lesar also discloses the anchoring portion having a tip (38).

Claim 41 is rejected under 35 U.S.C. 103(a)) as being unpatentable Plourde in view of DE Patent No. 19637985 to Gerhard (IDS).

Unlike Plourde, Gerhard provides a bore (not numeral) (Figs. 1 & 3) extending through the anchoring portion so that water disposed therein may consequently exit from the bore in the anchoring portion of the basic body.

It would have been obvious to have provided a bore through the anchoring portion of the basic body as taught by Gerhard in order to allow water disposed therein may consequently exit from the bore in the anchoring portion of the basic body. Notwithstanding, it would have been an obvious matter of design choice to make a hole through the anchoring portion, since applicant has not disclosed that a hole/bore solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the hole/bore formed through any portion of the basic body other than the anchoring portion.

Claim 41 is also rejected under 35 U.S.C. 103(a)) as being unpatentable Lesar in view of US Patent No. 5,881,495 to Clark.

Unlike Lesar, Clark provides a bore (56) (Fig. 6) extending through the anchoring portion so that water disposed therein exit from the bore in the anchoring portion of the basic body.

It would have been obvious to have provided a bore through the anchoring portion of the basic body as taught by Clark in order to allow water exit from the bore in the anchoring portion of the basic body. Notwithstanding, it would have been an obvious matter of design choice to make a bore or hole through the anchoring portion, since applicant has not disclosed that a hole/bore solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the

hole/bore formed through any portion of the basic body other than the anchoring portion.

Response to Arguments

3. Applicant's arguments filed 7/08/03 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion or teaching to combine the references as argued on pages 2 and 3 of the amendment, First, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Second, the examiner also recognizes that there is also no requirement that a motivation to make the modification to be expressly articulated. The test for combining references is what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170 USPQ 209 (CCPA 1971). In addition, the conclusion of obviousness may be made from "common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference" In *re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). In this case, a specific hint or suggestion or teaching may not be needed from the reference for the conclusion of obviousness. Nevertheless, Haldric et al. patent suggests that there are benefits to

have formed a basic body by hammering of a cylindrical tube by means of at least one hammer which is radially movable relative to the axis of the tube to be shaped without the use of a complex machine. This suggestion provides motivations for one of ordinary skill in the art to focus more on hammering technique in order to save the costs of employing a complex machine. Therefore, using the hammering technique to deform the tube in combination with the teaching of the prior art would have been obvious for the reasons as pointed out in the previous office action. In addition, referring the device to the process steps such as hammering or forming by hammering is not accorded patentable weight in the product-by-process claim. It is well settled that the patentability of a product does not depend on its method of production. Product -by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 USPQ 15.

With respect to the argument on page 4, last paragraph, Applicant's argument that "there is no reasonable expectation of success that the teaching of Haldric et al when combined with Plourde or Lesar would arrive at an operative embodiment...and there is no indication that hammering the anchoring device of Plourde or the anchor of Lesar if modified by Hadric would result in a sufficiently strong and durable anchoring device or anchor." In response, the examiner respectfully submits that: First, the examiner cited the reference of Plourde and/or Lesar in combination with Haldric et al. to show the teaching of forming a basic body by hamerring of a cylindrical tube that is well known in the art. As a matter of fact, there is no needed to show or combine the teaching of Haldric et al. since, as mentioned above that the patentability of a product

does not depend on its method of production. Product -by-process claims are not construed as being limited to the product formed by the specific process recited. And further, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not given patentable weight. Second, Applicant argues based on features such as "sufficiently strong and durable anchoring device", which are not claimed in the claims. Nevertheless, the recitation that an element is "sufficient" to perform, a given function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

The rejections based on Plourde in view of Haldric et al. and/or Lesar in view of Haldric et al. are, therefore, still maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Le, whose telephone number is 703.305.8244. The Examiner can normally be reached on Monday through Thursday, 9:00-6:00 and alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for official communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Group receptionist at 703.308.2168.



Tan Le
Patent Examiner
AU 3632
October 3, 2003



RAMON O. RAMIREZ
PRIMARY EXAMINER
ART UNIT 3557632